

SEP 27 2006

Application No. 10/013,049
Amendment dated September 25, 2006
Reply to Office Action of June 27, 2006

Docket No.: 10086/2 (14420-00004-US)

REMARKS

The following remarks are responsive to the Office Action dated June 27, 2006. Claims 1-13, 15-29 and 31-39 are currently pending in this application and are subject to examination. Reconsideration of these pending claims is respectfully requested in view of the following remarks.

Claims 22-29, 31-34 and 39 are indicated as containing allowable subject matter.

Claims 1-13, 15-21 and 35-38 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner alleges that these claims are not enabled by the disclosure since they do not include an additional step of contacting the composition with at least one microorganism, or least one enzyme located from the at least one microorganism, in an amount and at a pH and temperature effective to dehalogenate residual quantities of organically bound halogen, which the Examiner deems critical or essential to the practice of the claimed invention. Applicants disagree that any such additional step is necessary to practice the claimed invention and respectfully traverse this rejection.

The Examiner concludes that a biodehalogenation step is critical to practice the claimed invention because (1) only Examples 3, 24 and 25 are drawn to enzyme treatment of a starting composition with a solids content of at least 15% by weight that establishes that the treated composition releases less about 100 ppm dry basis of CPD when stored for 24 hours at 50 °C at a pH of about 1.0, and (2) Examples 3, 24 and 25 all employ a biodehalogenation step. The Examiner appears to have arrived at this conclusion after only reviewing the Examples of the present application. The Examiner does not mention whether a biodehalogenation step is disclosed as critical to the practice of the claimed invention elsewhere in the present application. Thus, the Examiner appears to have based the above rejection solely upon consideration of the Examples instead of upon consideration of the entire contents of the present application.

The Manual of Patent Examining Procedure States ("MPEP") states that "[i]n determining whether an unclaimed feature is critical, the entire disclosure must be considered." MPEP § 2164.08(c) (citing *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976)).

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Thus, the Examiner must take the entire contents of the present application into consideration before determining that an additional biodehalogenation step is critical to practicing the claimed process. Section 2164.08(c) of the MPEP further states that “[a]n enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made *only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended*. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.”

There is no language anywhere in the specification of the present application stating that a biodehalogenation step, or any other additional step, is critical to practice the claimed process. Instead, the specification clearly discloses that no additional step is necessary to practice the claimed process. Applicants respectfully direct the Examiner’s attention to page 15, line 27 to page 16, line 2 of the specification, which discloses that “[t]he enzyme treatment can be applied on resins as produced in a resin synthesis process *without further treatment*.” This same section of the specification discloses that the resins *can be* (i.e., may optionally be) treated before, after or before and after the enzyme treatment by various other processes. Next, Applicants respectfully direct the Examiner’s attention to page 17, line 22 to page 18, line 27 of the specification, which distinguishes between the levels of CPD that may be released and/or produced by the resin where the enzyme treatment is applied without need for further treatment (page 17, line 22 to page 18, line 8) and where an additional treatment is applied prior to, subsequent to or simultaneously with the enzyme treatment (page 18, lines 9-27). Next, Applicants respectfully direct the Examiner’s attention to page 31, line 20 to page 32, line 15 of the specification, which reiterates that the enzyme treatment can be applied on resins without further treatment and that such further treatment before, after or before and after the enzyme treatment is optional. Thus, the specification of the present application contains specific language disclosing that no additional step, biodehalogenation or otherwise, is necessary to practice the claimed process.

The Examiner also alleges that Applicants admit that (1) removing CPD present in the resin is critical to the claimed invention, and (2) the present claims should at least include a step of removing CPD from the resin while not necessarily being limited to a biodehalogenation step.

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Applicants have made no such admissions, nor can these alleged admissions reasonably be inferred from any of Applicants' previous communications with the Examiner. In the Responses dated July 26, 2005 and April 14, 2006, Applicants stated only that the present application contains enabling disclosure for a number of alternative additional treatment steps besides biodehalogenation to reduce and/or remove CPD from the resin. As is clear from the present application when considered in its entirety, these additional treatment steps are optional and therefore not critical to the practice of the claimed invention.

The present specification (1) does not specify that a biodehalogenation step, or any other additional step, is critical to practice the claimed process, and (2) unambiguously discloses that no additional step is necessary to practice the claimed process. Thus, Applicants respectfully request that the above rejection under 35 U.S.C. § 112, first paragraph be withdrawn and that all pending claims be allowed.

Enclosed is an authorization to act in a representative capacity.

Applicants believe no fee is due with this response. However, should any fees be required in connection with this Response, authorization is hereby made to charge any fees due or outstanding, including any extension fees, or credit any overpayment, to Deposit Account No. 03-2775 (Connolly Bove Lodge & Hutz LLP) under Order No. 10086/2 (14420*4) from which the undersigned is authorized to draw.

Dated: September 27, 2006

Respectfully submitted,

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